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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,159	04/25/2001	Yin Luo	RIGL-010CIP2	8575
24353	7590	05/26/2004	EXAMINER	
BOZICEVIC, FIELD & FRANCIS LLP 200 MIDDLEFIELD RD SUITE 200 MENLO PARK, CA 94025			RAO, MANJUNATH N	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/843,159	<b>Applicant(s)</b> LUO ET AL.	
	<b>Examiner</b> Manjunath N. Rao, Ph.D.	<b>Art Unit</b> 1652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-30 and 38-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-30 and 38-42 is/are rejected.
- 7) ☒ Claim(s) 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Claims 27-30, 38-43 are currently pending and are present for examination.

Applicants' amendments and arguments filed on 3-11-04, have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Specifically Examiner has withdrawn the rejections under 35 U.S.C. 112, 1st paragraph and under 35 U.S.C. 102(b) in view of the persuasive arguments presented by the applicant. Examiner has withdrawn the rejections under Double patenting rules in view of the Terminal Disclaimer filed by the applicant.

### ***Drawings***

Drawings submitted in this application are accepted by the Examiner for examination purposes only.

### ***Terminal Disclaimer***

The terminal disclaimer filed on 3-11-04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,617,102 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 27-30, 38-42 rejected under 35 U.S.C. 102(e) as anticipated by Chi et al. WO 0077225, Pub 12-21-00, Filed 6-9-00, US priority 6-11-99, cited in IDS) or Christensen et al. (WO 0100849, Pub 4-1-01, Filed 6-28-00, US priority 6-29-1999). This rejection is based upon the public availability of a printed publications/patent. Claims 27-30, 38-42 of the instant application are drawn to a method for screening for a candidate bioactive agent capable of modulating PARP activity comprising the steps of providing a TaHo protein, a candidate agent and a source poly ADP-ribose; and determining the amount of poly ADP-ribose associated with said TaHo protein wherein the TaHo protein has an amino acid sequence that is at least 95% identical to SEQ ID NO:3 or 4 or is encoded by a nucleic acid having at least 90% identity to the nucleic acid sequence set forth in SEQ ID NO:1 or 2, wherein the bioactive agent is a small molecule or a peptide and wherein said source of poly ADP-ribose is selected from a group consisting of NAD, biotinylated NAD or radioactively labeled NAD. Chi et al. and Christensen et al. disclose an identical method of assaying for compounds that modulate the activity of a Tankyrase having PARP activity and provide said protein wherein said protein has more than 95% sequence identity with SEQ ID NO:3 or 4 and therefore encoded by a polynucleotide having at least 90% sequence identity with SEQ ID NO:1 or 2 (see enclosed sequence alignments). Therefore, Chi et al. or Christensen et al. anticipate claims 27-30, 38-42 as written.

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Examiner acknowledges that applicants had overcome a previous rejection under 35 U.S.C. 102(e) by submitting a 37 CFR 1.131 Declaration swearing behind the date of the reference of Berthelsen et. al. While reviewing the prior art data again, Examiner has found the above references which have an earlier prior dates than that of Berthelsen et al. Hence the above rejection.

***Allowable Subject Matter***

Claim 43 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

None of the claims are allowable.


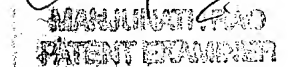
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Manjunath N. Rao

May 18, 2004